

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants : Joseph M. Asher, et al.  
Application No. : 10/822,484 Confirmation No. : 3028  
Filed : April 12, 2004  
For : A LOTTERY AND AUCTION BASED TOURNAMENT  
ENTRY EXCHANGE PLATFORM  
Group Art Unit : 3696  
Examiner : Ella Colbert

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Sir:

Applicants request review of the Final Rejection of June 17, 2008 in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reasons stated on the attached sheets.

**REMARKS**

For the following reasons, Applicants request review of the Final Rejection of June 17, 2008 in the present application.

**I. THE EXAMINER FAILS TO ESTABLISH A *PRIMA FACIE* CASE OF OBVIOUSNESS OF AT LEAST CLAIM 3**

To reject claims under 35 U.S.C. § 103, an examiner must show an un rebutted *prima facie* case of obviousness. In re Rouffet, 149 F.3d 1350, 1355 (Fed. Cir. 1998). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981 (CCPA 1974).

In the present application, the Examiner fails to show that the cited portions of Stronach, U.S. Patent Application Publication No. 2004/0229671 (hereinafter Stronach), and Gebb, U.S. patent 6,067,532 (hereinafter Gebb), disclose all the limitations of independent claim 3 and as such, fails to establish a *prima facie* case obviousness of at least claim 3.

Specifically, at pages 2-6 of the Office Action, the Examiner rejects claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Stronach in view of Gebb. Claim 3 recites in part:

*receiving, from a second user, a short sale order associated with the at least one entry of the first set of entries;*

*matching the buy order with the at least one short sale order to create a short sale;*

*settling, at a predetermined time, the short sale.*

In rejecting claim 3, the Examiner states that “Stronach fail[s] to teach” such limitations but rather, asserts that Gebb teaches the limitations. (Office Action, pages 5-6). Specifically, the Examiner states:

**Gebb does not use the terms ‘short sale.’ However, a ‘short sale’ is interpreted as being a sale that takes place in a short period of time (‘predetermined amount of time from consignment’) in col 7, lines 42-52.**

Col. 8, lines 22-35 discloses the settlement of the short sale  
(predetermined amount of time).

(Office Action, pages 16-17) (bold emphasis added)

MPEP § 2111 reads as follows:

During patent examination, the pending claims must be ‘given their  
broadest reasonable interpretation **consistent with the specification.**’  
(MPEP § 2111).

During examination, the claims must be interpreted as broadly as their  
terms reasonably allow.... This means that the words of the claim must be  
given their plain meaning unless **\*\*>the plain meaning is inconsistent  
with< the specification.** (MPEP § 2111.01 (I)).

(bold and underlined emphasis added).

The Examiner’s interpretation of “short sale” to mean “a sale that takes place in a short  
period of time” is inconsistent with the specification. In particular, the specification makes clear  
that “short sale” does not mean “a sale that takes place in a short period of time.” Rather, the  
specification clearly discloses that a “short sale” is when a user sells an entry “they do not own.”  
See, for example, page 7, lines 18-32 of the specification, which is reproduced below:

In addition to buying or selling an entry, users may make a request  
to sell short (and/or buy long). **For instance, a user may request  
to sell short an entry they do not own any time they think it is  
overpriced. If a user completes a short sale, then the user is  
appropriately associated with the entry being sold short and at  
the determining event (e.g., at the end of the tournament) a  
determination is made whether the user owes money or is due  
money in addition to a payout from the pool.** For example,  
assuming a user sees that Oklahoma is trading at \$2,000, the user  
might consider that entry to be overpriced. In other words, given  
the user's assessment of the chances that Oklahoma will win the  
tournament, the user believes that \$2,000 is too much to pay for an  
Oklahoma entry. **The user may attempt to sell Oklahoma short  
at \$2,000 (even though the user does not own the Oklahoma  
entry).** Another user may purchase Oklahoma at \$2,000 (the  
actual market price). Then the short seller must cover his short

position at a future time, when he hopes the price for Oklahoma will have fallen. For example, if at the time he covers his short position, the price of Oklahoma is \$1,800, then he will have profited \$200.

(bold emphasis added)

Because the Examiner's interpretation of "short sale" is inconsistent with the specification, the Examiner fails to show that the cited portions of Gebb disclose the above limitations of claim 3. Accordingly, because the Examiner has not shown that all limitations of claim 3 are taught or suggested by Stronach and/or Gebb, the Examiner fails to establish a *prima facie* case of obviousness of at least claim 3.

## II. CONCLUSION

Because the Examiner fails to establish a *prima facie* case of obviousness of at least claim 3, withdrawal of the rejection is respectfully requested.

Respectfully submitted,

/Glen R. Farbanish/

November 20, 2008

Date

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